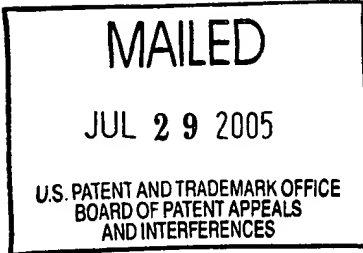


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte WENG CHANG,
TIEN-I BAO, YAOYI CHEN
and
SYUN-MING JANG

Application 09/821,554

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on July 12, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith electronically returned to the examiner. The matters requiring attention prior to docketing are identified below.

On April 14, 2003, appellants filed an amendment to claims 4 and 11. It is noted that the language of claims 4 and 11 in the Appendix to the Appeal Brief filed September 22, 2003 differs from its last amended version. 37 CFR § 1.192(c)(9)

(2003) requires that the Appendix to the Appeal Brief contain a correct copy of the claims involved in the appeal.

A review of the record indicates that the Final Rejection mailed April 22, 2003 lists the following rejections:

1. Claims 1 and 3 are rejected under 35 U.S.C. 102(e). . . ;
2. Claim 2 is rejected under 35 U.S.C. 103(a). . . ;
3. Claims 4 and 7 are rejected under 35 U.S.C. 102(e). . . ;
4. Claims 5 and 6 are rejected under 35 U.S.C. **103(a)**. . . ; [emphasis added]
5. Claims 8 and 10 are rejected under 35 U.S.C. 102(e). . . ;
6. Claim 9 is rejected under 35 U.S.C. 103(a). . . ;
7. Claims 11, 14, and 15 are rejected under 35 U.S.C. 102(e). . . ; and
8. Claims 12 and **13** are rejected under 35 U.S.C. **103(a)**. . . . [emphasis added]

However, in the Examiner's Answer mailed December 15, 2003, lists the following grounds of rejection:

1. Claims 1, 3, 4, **6**, 7 and 8, 10, 11, **13**, 14, and 15 are rejected under 35 U.S.C. **102(e)**. . . ; and [emphasis added]

2. Claims 2, 5 and 9, 12 are rejected under
35 U.S.C. 103(a)

It appears that the § 102(e) rejection of claims 1, 3, 4, 6, 7, and 8, 10, 11, 13, 14 and 15 listed above is a new ground of rejection. Section § 1208.01 of the Manual of Patent Examining Procedure (MPEP) (Eighth Edition, Rev. 1, Feb. 2003), states:

37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. At the time of preparing the answer to an appeal brief, however, the examiner may decide that he or she should apply a new ground of rejection against some or all of the appealed claims. In such an instance where a new ground of rejection is necessary, the examiner should reopen prosecution. The examiner must obtain supervisory approval in order to reopen prosecution after an appeal. See MPEP § 1002.02(d).

Finally, § 707.08 of the Manual of Patent Examining Procedure (MPEP) (Eighth Edition, Rev. 2, May 2004) states:

707.08 Reviewing and Initialing by Assistant Examiner

The full surname of the examiner who prepares the Office action will, in all cases, be typed at the end of the action. . . .

After the action is typed, the examiner who prepared the action reviews it for correctness. The surname or initials of the examiner who prepared the action and the date on which the action was typed should appear below the action. If the examiner does not

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have the authority to sign the action, he or she should initial above the typed name or initials. . . .

The Examiner's Answer mailed April 7, 2005 is deficient in that there is no signature or initials for Lynette T. Umez-Eronini. Correction is required.

Accordingly, it is

ORDERED that the application is returned to the

Examiner:

1) for notification to appellants to submit a corrected Appendix to the Appeal Brief filed September 22, 2003 to replace the existing defective Appendix, or for the examiner to issue a Supplemental Examiner's Answer to officially correct claims 4 and 11;

2) for a determination regarding the status of claims 6 and 13 in the grounds of rejection of the Examiner's Answer mailed December 23, 2003;


3) for taking corrective action regarding the signature or initials for Lynette T. Umez-Eronini;

4) for written notification to appellants regarding the action taken; and

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5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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